

### REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 11, 14-17, 19, 20, 21, 24-28 and 30-32 are rejected under 35 USC 102(b) as being anticipated by the U.S. patent to Lee et al.

Claims 22 and 23 have been allowed by the Examiner.

Claim 33 was withdrawn from consideration.

The Examiner's indication of the allowance of Claims 22 and 23 has been gratefully acknowledged. In connection with this indication these claims have been retained as they were, without any changes.

After carefully considering the Examiner's grounds for rejection of the claims over the art, Claim 11, the broadest claim on file, has been amended to more clearly define the present invention and to distinguish it from the prior art.

In particular, it is now stated in Claim 11 that the safety element extends at least from the first end of the elastic element to the

second end of the elastic element, which second end is located opposite to the first end of the elastic element.

This feature of Claim 1 is disclosed in Figure 2.

Applicants have also added new Claims 34-42. The features of Claim 34 are shown in Figure 2, the features of Claim 35 are disclosed in first sentence on page 4 of the specification, the features of Claim 36 are disclosed in the second sentence on page 10 of the specification. The features of Claim 37 are disclosed in former Claim 11 and in Figure 2, the features of Claim 38 are disclosed in former Claim 11, the features of Claim 39 are shown in Figure 2. The features of Claim 40 are disclosed in the specification, in particular on page 9, line 17 to page 10, line 6. The features of Claim 41 are disclosed in former Claim 11, and finally, the features of Claim 42 are shown in Figure 2.

Turning now to the Examiner's grounds for rejection of the claims over the art, in particular to the Examiner's rejection of Claim 11, it is respectfully submitted that the U.S. patent to Lee discloses a vibration isolator, which is comprised of parallel flexible beams of rectangular cross sections, connected between parallel mounting plates to permit parallel translation of the mounting plates in substantially one parallel direction, only thereby permitting the vibration absorber to absorb relative induced

motion or vibration in one preferred direction, only while retaining relative stiffness for control in the remaining two coordinate directions, as well as restraining torsional twist.

The patent to Lee does not disclose a rigid safety element. In particular, the flexible beams in the patent to Lee are not rigid.

The patent to Lee does not disclose a safety element extending at least from the first end of the elastic element to a second end of the elastic element, which second end of the elastic element is located opposite to the first end of the elastic element.

It is therefore believed to be clear that the new features of the present invention which are now defined in amended Claim 1 are not disclosed in the patent to Lee.

The same is true with respect to Claims 37 and 40.

It is further respectfully submitted that not only the patent to Lee does not disclose the above mentioned features, but these features cannot be considered as obvious from the reference. The task which underlines the present invention is to provide a hand power tool, which could be used safely. This task is solved for a hand power tool by building

the safety element in a rigid way and by the feature that the safety element extends at least from the first end of the elastic element to the second end of the elastic element, which second end of the elastic element is located opposite to the first end of the elastic element. Thereby, the hand power tool can be used safely. In particular, the gripping part is fixed safely at the mounting part. In particular, the elastic element is fastened safely at the mounting part.

The patent to Lee does not disclose any hint, suggestion, or motivation which could have lead a person skilled in the art at the time of the invention, to the invention disclosed in the present application and defined in the above mentioned claims. In particular, the patent to Lee does not disclose a rigid safety element. Moreover, the patent to Lee does not disclose a safety element extending at least from the first end of the elastic element to the second end of the elastic element, which second end is located opposite to the first end.

The claims were rejected over the patent to Lee as being anticipated. In connection with this, it is believed to be advisable to cite the decision In Re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every

element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Lee does not disclose each and every element which is now defined in Claims 11, 37 and 40.

Therefore, the anticipation rejection over the patent to Lee applied against the original claims should be considered as not tenable with respect to the above mentioned independent claims and should be withdrawn.

The new features of the present invention as explained hereinabove and defined in the above-mentioned independent claims were not disclosed in the reference, and the reference do not have any hint, suggestion, or motivation for these features. In order to arrive at the applicant's invention from the teachings of the reference, it is not just sufficient to use the teaching of the reference, but instead the reference has to be fundamentally modified by including into it the new features of the present invention which are now defined in the above listed independent claims and which were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, as explained hereinabove, the present invention provides for the highly advantageous results which cannot be accomplished by the device disclosed in the reference. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that Claims 11, 37 and 40 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the corresponding independent claims, they share their allowable features, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

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